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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91225315
Party	Plaintiff Delta Faucet Company
Correspondence Address	MARY FRANCES LOVE ASPIRE IP 444 E PIKES PEAK AVE, SUITE 105 COLORADO SPRINGS, CO 80903 UNITED STATES maryfran@aspireip.com
Submission	Motion to Consolidate
Filer's Name	Mary Frances Love
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Date	02/04/2016
Attachments	2016-2-4 Motion to Consolidate with Love Dec Signed.pdf(169556 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DELTA FAUCET COMPANY,	)	
	)	
Opposer ,	)	
	)	
v.	)	Opposition No. 91/225315
	)	Serial No. 86/720985
AS IP HOLDCO, LLC,	)	Mark: DXV LYNDON
	)	
Respondent.	)	

**OPPOSER’S MOTION TO CONSOLIDATE PENDING INTER PARTES  
PROCEEDINGS and STAY DISCOVERY  
AND BRIEF IN SUPPORT**

Opposer Delta Faucet Company (“Opposer” or “Delta”), requests that the Board consolidate the above-captioned proceeding with pending Cancellation No. 92/061540 for the purposes of discovery and trial proceedings. In support of its Motion, Delta provides the following background and legal basis. AS IP HOLDCO, LLC (“Respondent” or “American Standard”) is the Respondent in this pending Opposition and the Respondent in the companion Cancellation. American Standard and Delta are hereinafter “the Parties.”

**STATEMENT OF FACTS**

Since as least as early as November 2009, Delta has used its trademark LINDEN in connection with “plumbing products, namely, faucets and showerheads” in International Class 11. Delta owns the following trademark application:

**U.S. Serial No. 86/361010 filed on August 8, 2014. This application is currently**

**suspended pending the resolution of Cancellation 92/061540.**

On November 24, 2014, the Examining Attorney assigned to Serial No. 86/361010 issued an Office Action refusing registration of the trademark LINDEN under Section 2(d) citing Respondent's registration for the trademark LYNDON. Respondent owns the following trademark registration:

**U.S. Reg. No. 4,625,940 filed on August 1, 2013 under Section 1(b) as intent to use for “plumbing fixtures, namely, lavatories, toilet bowls, toilet tanks, bathtubs, shower stalls, urinals, bidets, hand wash basins in the nature of sinks, vanity basins in the nature of sinks, and kitchen sinks; plumbing fittings, namely faucets, bathtub spouts and shower heads all in International Class 11.”**

On August 13, 2014, Respondent filed a Statement of Use showing a specimen consisting of printed “Installation Instructions” and claimed a date of first use and first use in interstate commerce of January 1, 2014. Despite the fact that the specimen was not an example of the trademark used on the goods under 15 U.S.C. § 1127, the PTO accepted the specimen of use. The PTO issued the Certificate of Registration on October 21, 2014.

On May 21, 2015, Delta filed a Petition to Cancel against Reg. No. 4,625,940. That matter is pending before the Board and Respondent filed a Motion to amend its Answer to the Cancellation on November 18, 2015. That Motion was granted on January 15, 2016 and the Board reset the trial dates.

On August 11, 2015, Respondent filed an application for the trademark DXV LYNDON. Respondent now owns the following pending trademark application:

**U.S. Serial No. 86/720985 filed on August 11, 2015 for “plumbing fixtures, namely, lavatories, toilet bowls, toilet tanks, bathtubs, shower stalls, urinals, bidets, hand**

**wash basins in the nature of sinks, vanity basins in the nature of sinks, and kitchen sinks; plumbing fittings, namely faucets, bathtub spouts and shower heads all in International Class 11.”**

This application was filed under Section 1(b) and accordingly, no specimen of use was submitted with the application. Prior to Respondent filing the DXV LYNDON application, the Parties discussed possible settlement of the pending Cancellation proceeding. During those discussions, Opposer clearly stated that it would not accept registration or use by Respondent of either LYNDON or DXV LYNDON in connection with the Class 11 goods in question. On December 11, 2015, Opposer filed this Opposition to the registration of DXV LYNDON.

Cancellation No. 92/061540 and Opposition No. 91/225315 are currently pending before this Board. Both proceedings involve the same parties. Furthermore, in both proceedings, Opposer Delta contends that there is a likelihood of confusion between its LINDEN trademark and the American Standard trademarks LYNDON and DXV LYNDON. In support of that contention, Opposer intends to rely upon its prior rights in its LINDEN trademark. Accordingly, there will be substantial overlap between the facts and legal theories in the two proceedings.

### **ARGUMENT**

Pursuant to 37 C.F.R. § 2.11(6), the procedure and practice of inter parties trademark proceedings shall be governed by the Federal Rules of Civil Procedure where applicable and appropriate and except as otherwise provided. Rule 42(a) of the Federal Rules of Civil Procedure provides that when actions which involve a common question of law or fact are pending before a court, that court may order all the actions consolidated to

avoid unnecessary costs and delay.

Consolidation of Cancellation No. 92061540 (“the Cancellation”) and Opposition No. 91225985 (“the Opposition”) will serve the interests of judicial economy because both cases have a common question of law in that both cases challenge the issuance of registrations of trademarks containing the designation “LYNDON.” Furthermore, consolidating the Cancellation and the Opposition will serve the interests of judicial economy because both proceedings have a common nucleus of facts. Indeed, the allegations of the Petition to Cancel and allegations of the Notice of Opposition are virtually identical.

The Cancellation and Opposition have common questions of law and fact that would serve the interests of justice, if consolidated. Furthermore, because the Cancellation is still in the discovery phase, consolidation of the two proceedings will not impose any prejudice on the parties. Thus, to preserve costs and prevent unnecessary delay, the above captioned Opposition and the Cancellation should be consolidated. *See, e.g., Industries, Inc. v. Lamb-Weston, Inc.*, 45 U.S.P.Q.2d 1293, 1297 (T.T.A.B. 1997)(granting motion to consolidate where both proceedings involved the same mark and contained virtually identical pleadings and finding that “[c]onsolidation will avoid duplication of effort concerning the factual issues in common and will thereby avoid unnecessary costs and delays”).

**REQUEST FOR STAY OF DISCOVERY**  
**OR RESET OF DISCOVERY DATES**

In the interest of justice as well as judicial economy, Opposer requests that the Board suspend the Cancellation and Opposition proceedings pending the Board’s ruling on

this Motion. Furthermore, Opposer requests that the Board set new discovery and trial dates for the consolidated proceeding. This request is necessary because Respondent amended the Answer filed originally in the Cancellation proceeding and Opposer needs additional time to review the new counterclaims and respond to same. New discovery requests will undoubtedly be required based on the new allegations in the Amended Answer. Alternatively, Opposer requests that the Board grant Opposer an extension of time in which to respond to the outstanding discovery requests pending in the Cancellation proceeding for the reasons stated below.

On November 13, 2015, Respondent allegedly served Opposer with Respondent's first set of Discovery requests<sup>1</sup> by U.S. Mail. Requests for email service from Respondent to Opposer relating to the matter were denied by the attorney for Respondent stating that because of "*significant email interruptions in our office in the past*" email service was not possible. (Love Declaration ¶ 10). Respondent's Discovery requests, allegedly mailed on November 13, 2015, did not reach the office of Opposer's attorney until November 28, 2015. (Love Declaration ¶ 9). On November 18, 2015, filed its MOTION TO AMEND ITS ANSWER AND STAY DISCOVERY with the Board. On November 18, 2015, Respondent served Opposer by U.S. Mail. The Motion did not reach Opposer's attorney until November 28, 2015. (Love Declaration ¶ 11).

On September 16, 2015, Opposer served Discovery Requests<sup>2</sup> on Respondent by U.S. Mail and sent courtesy copies via email on September 18, 2015. (Love Declaration ¶

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<sup>1</sup> Respondent's First Request for Production of Documents, First Set of Interrogatories, and First Set of Admissions include a Certificate of Service dated November 13, 2015.

<sup>2</sup> Opposer's First Set of Interrogatories and Request for Admissions dated September 16, 2015.

6). Although Respondent's responses were due on November 20, 2015<sup>3</sup>, Opposer received no documents and no explanation. (Love Declaration ¶ 7).

Respondent requested a stay of Discovery in its Motion to Amend Its Answer and Stay Discovery. Apparently relying upon its request for a stay of discovery, Respondent has been silent as to when it will produce responses to the outstanding discovery. (Love Declaration ¶ 7). On January 25, 2016, the Board issued a supplemental Order in the Cancellation proceeding allowing Respondent until February 15, 2016 in which to respond to Opposer's discovery requests. (Love Declaration ¶ 12). The effect of the Board's order is to grant Respondent 152 days to respond to Petitioner's discovery requests. This is assuming that Respondent responds on February 15, 2016. Petitioner's responses to discovery were arguably due on December 18, 2015. However, that date was suspended pending the Board's decision on Respondent's Motion to Amend Its Answer and Stay Discovery. Since that Motion was granted on January 15, 2016, Petitioner's discovery responses are now due on February 15, 2016. That date should be suspended pending the Board's decision on this Motion.

In order to proceed with the matter in a fair and just manner, Delta requests that the Board stay all discovery due dates in the Cancellation and Opposition. Alternatively, Delta requests that the Board grant it until thirty (30) days after the Board's decision on this Motion in which to respond to Respondent's discovery requests. Delta has shown the requisite good cause as to why the Board should suspend the pending proceedings pending the Board's decision on this motion.

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<sup>3</sup> Delta granted Respondent a thirty (30) day extension of time in which to respond to discovery requests, connected to the Cancellation, from October 20, 2015 to November 20, 2015.

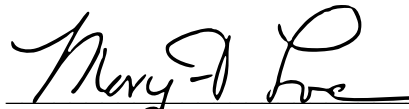
**CONCLUSION**

For all the forgoing reasons, Opposer's Motion to (1) Consolidate and (2) suspend proceedings or reset discovery and trial deadlines pending the Board's decision and (3) extend the deadline to respond or stay discovery until thirty (30) days after the Board issues its decision and resets discovery and trial deadlines accordingly, should be granted.

Respectfully submitted,

DELTA FAUCET COMPANY

Dated: February 4, 2016

By:   
Mary Frances Love  
Aspire IP, LLC  
3509 Connecticut Avenue, PMB 130,  
Washington, D.C. 20008  
Attorney for Opposer and Member of the  
DC Bar.



**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing OPPOSER'S MOTION TO CONSOLIDATE PENDING INTER PARTES PROCEEDINGS AND SUSPEND OR ENLARGE DISCOVERY AND BRIEF IN SUPPORT was mailed by First Class mail, postage prepaid on February 4, 2016 upon attorney of record for Respondent:

Ralph A. Cathcart, Esq.  
LADAS & PARRY LLP  
1040 Avenue of the Americas  
New York, NY 10018-3738

Date: February 4, 2016

Name: Sherri Weisbeck-Raslich

Signed:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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DELTA FAUCET COMPANY,	)	
	)	
Opposer ,	)	
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v.	)	Opposition No. 91/225315
	)	Serial No. 86/720985
AS IP HOLDCO, LLC,	)	Mark: DXV LYNDON
	)	
Applicant.	)	

**DECLARATION OF MARY F. LOVE, ESQ.**  
**IN SUPPORT OF OPPOSER’S MOTION TO CONSOLIDATE PENDING**  
**INTER PARTES PROCEEDINGS AND STAY OF DISCOVERY**

I, Mary F. Love, declare that the following is true and correct pursuant to 28 U.S.C. § 1746:

1. I am the Trademark Group Leader at Aspire IP, attorneys for Opposer Delta Faucet Company. I am familiar with the subject matter of this Cancellation based upon my own personal knowledge and familiarity with the case files and documents.
2. This Declaration is submitted in support of Opposer’s Motion to Consolidate Pending Inter Partes Proceedings and Stay Discovery and Brief in Support. The dates in this Declaration relate mainly to the Petition to Cancel Registration No. 4,625,940 which is the subject of Cancellation No. 92/061,540. Accordingly, AS IP Holdco, LLC is referred to as the “Respondent” and Delta Faucet Company is referred to as the “Petitioner” or “Delta.”

3. On May 21, 2015 Petitioner Delta Faucet Company filed a Petition to Cancel Respondent's Lyndon Registration No. 4,624,940. Cancellation No. 92/061,540.
4. Thereafter, with Petitioner's consent, Respondent obtained an extension of time to file an Answer, up to and including, July 30, 2015.
5. On August 11, 2015, Respondent filed an application for the trademark DXV LYNDON, Serial No. 86/720985.
6. On September 16, 2015, Petitioner served Discovery Requests on Respondent and sent courtesy copies via email on September 18, 2015.
7. Thereafter, on October 8, 2015, Petitioner granted Respondent an additional 30 days, until November 20, 2015 in which to respond to Petitioner's outstanding discovery requests. No further extensions were granted to Respondent, and no explanations on the lack of response were offered to Petitioner's attorney.
8. On December 11, 2015, Petitioner filed a Notice of Opposition against Application Serial No. 86/720985 for the mark DXV LYNDON, now pending as Opposition No. 91/225315.
9. On November 13, 2015, Respondent served Discovery requests on Petitioner. Those documents were sent via U.S. Mail and arrived at attorney for Petitioner's office on November 28, 2015.
10. Petitioner requested email service from Respondent or, alternatively, "courtesy copies" via email. This offer was denied on November 24, 2015. The attorney for Respondent explained, via email, that his law firm was unable to use email for service of documents because of "significant email interruptions in our office in the past."

11. On November 18, 2015, Respondent filed a Motion to Amend Its Answer And Stay Discovery. That motion was sent via U.S. Mail and arrived at attorney for Petitioner's office on November 28, 2015.

12. On January 15, 2016, the Board granted Petitioner's motion and on January 25, 2016, the Board issued a supplemental order extending the time for Respondent's discovery response to February 15, 2016.


13. Petitioner's responses to Respondent's discovery requests were due on December 18, 2015. That date was stayed at the time of Respondent's Motion to Amend Its Answer. Delta now calculates that its responses to the Respondent's discovery requests are due on February 15, 2016 and that date is again stayed pending the order of the Board on Petitioner's pending Motion to Consolidate.

14. As of today, neither party has responded to any discovery request. As such, neither party is prejudiced by a stay of discovery in the Cancellation and Opposition proceedings.

Respectfully submitted,

DELTA FAUCET COMPANY

Dated: February 4, 2016

By: \_\_\_\_\_

Mary Frances Love  
Aspire IP, LLC  
3509 Connecticut Avenue, PMB 130,  
Washington, D.C. 20008  
Attorney for Opposer and Member of the DC  
Bar.

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing Notice of Opposition was mailed by First Class mail, postage prepaid on February 4, 2016 upon attorney of record for Applicant:

Ralph A. Cathcart, Esq.  
LADAS & PARRY LLP  
1040 Avenue of the Americas  
New York, NY 10018-3738

Date: February 4, 2016

Name: Sherri Weisbeck-Raslich

Signed: